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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,537	06/11/2001	Suresh D. Amberkar	13088	2610

7590 05/29/2003

Lisa M. Soltis  
Illinois Tool Works Inc.  
3600 West Lake Avenue  
Glenview, IL 60025

EXAMINER
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HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/29/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/878,537

Applicant(s)

Amberkar et al.

Examiner

Bruce Hess

Group Art Unit

1774

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 3-17-03 (Election)
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) 12-19 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-11 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. Upon reconsideration, the image portion (i.e., A<sub>1</sub> or B<sub>1</sub>) of the election of species is no longer adhered to. Only the receptive layer portion remains in effect.
2. Claims 1, 2, 4, 5 and 11 are rejected under 35 USC 102(b) as being anticipated by the patent to Fujimura et al. (U.S.P. 5,006,502).
3. Claims 3 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimura et al.

Fujimura et al. teach an article (e.g., porcelain or earthenware) having applied thereto a size coat, a polyacrylate image receptive layer and a sublimable image (see Fig. 6; column 3, lines 55, 56 and 61-3; column 5, lines 17-21; and column 14, lines 30-31). The experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine layer thicknesses and adhesive T<sub>g</sub>) fails to render applicants' claims patentable in the absence of unexpected results.

4. The patents to Ebisch et al. (U.S.P. 5,658,677) and Daems et al. (U.S.P. 6,156,416) are cited to show the use of transfer foils for the application of toner images to metal and glass articles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Hess whose telephone number is (703) 308-2402. The examiner can normally be reached on Monday to Friday 9 Am to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7115 for regular communications and (703) 308-7115 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

B. Hess/mn  
May 20, 2003

A handwritten signature in black ink, appearing to read "Bruce Hess". The signature is written in a cursive, flowing style.

BRUCE H. HESS  
PRIMARY EXAMINER